REMARKS/ARGUMENTS

The Office Action

In the above-mentioned non-final Office Action, claims 19-26, 28-29, 65, 69, 71-73, 77, 79-81, 92, 95-97, 102-103, 105-106 and 110 were rejected as being anticipated by U.S. Patent 6,149,518 (Farrow); claims 44-45, 47-48, 50, 52, 54-55, 57-62, 67, 75, 84-85, 87-89, 98-101, 104 and 107-109 were rejected as being anticipated by U.S. Patent 6,479,118 (Atkinson); claims 49, 56, 63-64, 68, 86 and 91 were rejected as being unpatentable over Atkinson; claims 27, 67, 70, 74, 78 and 92 were rejected as being unpatentable over Farrow; and claim 65 was rejected as failing to comply with the written description requirement.

Discussion

1. The Claims

In further response to the non-final Office Action, minor amendments have been made to claims 19, 21-25, 44, 50, 52, 57, 58, 61, 65, 67, 69, 73, 75, 77, 84, 85, 89, 92 and 109. Some of these amendments simply point out that certain of the lines are fold lines. In this regard, the Examiner's attention is directed to FIGS. 4, 5 and 6 of the present application. Also, many of the "wherein clauses" have been rewritten so as to not be in "wherein" format. New claims 111-133 have been added, and claims 20 and 45 have been cancelled.

2. "Capable of"

The Examiner in his rejections stated that '[t]he phrase 'capable of' has not been given patentable weight because it is not found to of [sic] positive limitation as it only require the ability to so perform. *In re Hitchinson*, 38 USPQ 38." Applicants respectfully disagree.

First, it is noted that the phrases "adapted to," "being constructed" and "being dimensioned" have also been used in the claims. The Examiner has accorded, without any explanation, no patentable weight to these phrases in his rejections. If the Examiner again rejects these claims and accords these phrases no patentable weight,

he is requested to provide Applicants with a detailed explanation including MPEP citations.

Second, the Examiner twice cited *In re Hitchinson*, 38 USPQ 38, when giving "capable of" no patentable weight. Counsel has been unable to locate that case. For purposes of this Supplemental Amendment, Counsel is assuming that the Examiner meant to cite *In re Hutchinson*, 69 USPQ 138.

Third, the Examiner's statement that the phrase "capable of" is not to be given patentable weight is an incorrect statement of the law.

In re Hutchinson, 69 USPQ 138, is a 1946 decision of the Court of Customs and Patent Appeals. It is not cited in the MPEP, because the decision is limited to its specific facts. Specifically, it held that a statement in the preamble that the laminated article was adapted for use in making a template or the like did not constitute a patentable limitation. It was a ruling on a specific "adapted for" phrase in a preamble.

MPEP 2173.05(g) states that "[t]here is nothing inherently wrong with defining some part of an invention in functional terms." It goes on to cite *In re Barr*, 170 USPQ 33 (CCPA) and *In re Venezia*, 189 USPQ 149 (CCPA 1976), which used the claim language "incapable of forming ..." and "adapted to be positioned ...", respectively, and which found that this was acceptable claim language which imparted patentable significance to the respective claims.

The law is not that terms in a claim which recite an intended use cannot be used to distinguish a claimed article over a prior art article. If the Examiner disagrees, he is respectfully requested in his next action to point out support in the MPEP or case law for his position.

The phrases "adapted to", "capable of", "dimensioned to," "constructed to," "structured to" and various variations and combinations of these phrases as set forth in the claims as pending in this application result in structural differences between the claimed invention and the prior art, Applicants respectfully contend. And these structural differences patentably distinguish the claimed invention over the prior art, a discussed below, and is readily apparent from the construction illustrated in FIGS. 4, 5 and 6.

3. The Prior Art

The following remarks on *Atkinson* and *Farrow* supplement those in the Amendment filed on July 10, 2006.

Line 24 of *Atkinson* is a perforated line (not a cut line). It is a tear line and not a fold line. It also extends through the backing (liner) sheet.

Farrow shows a first label 18 (having Drug Name printed on it) and a second label (unnumbered, but also having Drug Name printed on it). Line 50 is a perforation line (not a cut line). Further, it is a tear line and not a fold line. It also does not extend between (or lie on a line which passes through) the first and second labels. Rather, it is spaced an offset distance from and is parallel to the first and second labels. Additionally, line 57 is not cut through the facestock sheet, but rather is an edge of the facestock label, as can be readily seen in FIG. 3.

For example, in new independent claim 125 *Atkinson* does not disclose the weakened line segment which does not penetrate the liner sheet and which defines a weakened fold line. And *Farrow* does not disclose the at least one cut line through the facestock sheet. It further does not disclose a weakened line segment which is in the facestock sheet, which does not penetrate the liner sheet and which defines a weakened fold line that passes through the label.

4. Written Description

The rejection of claim 65 as failing to comply with the written description requirement is respectfully traversed. The phase "not being a weakened line" finds clear support in the application. As an example, the Examiner's attention is directed to FIG. 4 which shows that the portion of line 180 that passes through label 174 is not a weakened line. His attention is additionally directed to FIG. 5 which clearly shows that the portion of line 148 that passes through label 174 is not a weakened line.

Concluding Remarks

Accordingly, it is respectfully contended that all of the claims now pending are in condition for allowance. Issuance of the Notice of Allowance at an early date is thus in order.

If there are any remaining issues, the Examiner is encouraged to telephone the below-signed counsel for Applicants at (310) 785-5384 to seek to resolve them.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 10-0440. Should such additional fees be associated with an extension of time, Applicants respectfully request that this paper be considered a petition therefor.

Respectfully submitted,

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